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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/581,353

Filed: May 31, 2006

For: **TREATMENT UNIT FOR THE WET-CHEMICAL ELECTROLYTIC TREATMENT OF FLAT WORKPIECES**

Inventors: Uwe Hauf, Henry Kunze, and Ferdinand Wiener

Examiner: Sylvia MacArthur

Art Unit: 1792

Atty Doc. No.: 084-06

RESPONSE TO ADVISORY ACTION OF JUNE 5, 2009

Commissioner for Patents

Filed Electronically

Dear Sir:

In the Advisory Action of June 5, 2009, the Examiner has noted that the rapid interchangeability of the insertion elements, while being argued, is not specifically recited in the claims. This feature has been argued as a benefit that is achieved by the structure that is already present in the claims, such structure being the presence of a plurality of conveying members carried in a single module system insertion element.

But the law is settled that the benefits of an invention; namely its criticality or exceptional result need not be recited in the claims; they only need to be present.

No less than authority than the United States Supreme Court, in *United States v. Bert N. Adams et al.* 383 U.S. 39, 15 L ed 2d 572, 86 S Ct 708 (1966) had before it just such an issues as is present here. In that case, the benefit of the battery under consideration there was its capacity for generating current which was exceptional:

Furthermore, its capacity for generating current
was exceptionally large in comparison to its size and weight. (pg. 575)

Neither of the two claims under consideration there said anything whatever about that